



Attorney Docket No. 0174.210US  
01620/16185US02

IN THE UNITED STATES  
PATENT AND TRADEMARK OFFICE

Applicant: Wilkinson, *et al.*

Serial No.: 10/081,526

Filed: February 21, 2002

For: "METHOD FOR IMPROVING OR  
ALTERING PROMOTER ENHANCER  
PROPERTIES"

Group Art Unit: 1639

Examiner: Teresa D. Wessendorf

CERTIFICATE OF MAILING

) I hereby certify that this paper (and all papers  
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) 1450 on:

March 22, 2005

) Donald J. Pochopien  
) Registration No. 32,167  
) Attorney for Applicants

RESPONSE TO RESTRICTION REQUIREMENT UNDER 35 U.S.C. § 121

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the Official Communication of 02/22/2005 (the "Official Action"), imposing a restriction requirement under 35 U.S.C. § 121, for which a response is due 03/22/2005, Applicants respond as follows:

**Response to the Restriction** begins on page 2 of this paper.

**Remarks/Arguments** begin on page 6 of this paper.

### **The Restriction:**

The Patent Office is imposing a restriction upon claims 1-48 of the present invention. According to the Patent Office, the application contains claims directed to a plurality of patentably distinct species of which the Applicants must make an election. As the Applicants understand the restriction requirement, the Applicants are required to elect a species of steps from each of A-D as listed below:

- A. Plurality of random polynucleotide segments selected from:
  - 1. random segments from at least two distinct promoters or enhancers as recited in claim 7;
  - 2. a plurality of random polynucleotide segments obtained by random cleavage as recited in claim 8;
  - 3. a plurality of random polynucleotide segments obtained by random amplification as recited in claim 9;
- B. A selection step as recited in one of claims 12, 13, 14, 15, 16, 18 or 25;
- C. A segment formation as recited in one of claims 17, 19, 20, 21, 22, 23, or 24;
- D. Progenitor polynucleotides as recited in one of claims 31, 32, 33, 34, 35, 36 or 37;  
and whether it consists of one (claim 38) or more than one (claim 39) transcriptional regulatory polynucleotides.

The Patent Office has acknowledged that currently claims 1 and 48 are generic.

### **The Election:**

In response, the Applicants elect as follows from each of groups A-D:

- A. Plurality of random polynucleotide segments selected from:
  - 1. random segments from at least two distinct ~~promoters or enhancers~~ gene regulatory elements as recited in claim 7;
- B. A selection step as recited in claim 12 as currently amended;
- C. A segment formation as recited in original claim 19, preferably in claim 19 as currently amended in more generic form to also incorporate claim 21; and

- D. Progenitor polynucleotides as recited in claim 32 as currently amended, and that it consists of more than one transcriptional regulatory elements as recited in claim 39.

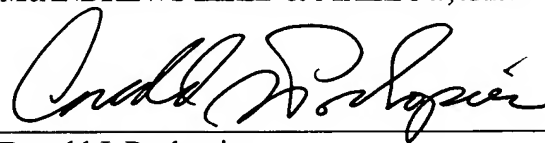
The Applicants will maintain the generic nature of their claims with the intent that if any generic claim is found allowable, the Applicants will be entitled to consideration of claims written to other dependent species.

Separately, the Patent Office requested that the Applicants identify all claims readable on the elected species. In response, the Applicants hereby state that claims 1-7, 10-12, 14, 16, 19, 21, 26-30, 32, 39-48 are readable on the elected species.

Respectfully submitted,

**McANDREWS HELD & MALLOY, LTD.**

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Date: March 22, 2005

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